REMARKS

It is noted, with appreciation, that the Examiner has indicated that claims 5 and 6 are allowed.

Claims 1, 5 and 6 have been objected to for the reasons set forth on page 2 of the Examiner's Office Action letter. Because of the amendments made to claims 1, 5 and 6, it is believed that the Examiner's objection has been eliminated.

Claims 1-4 have been rejected by the Examiner under the judicially created Doctrine of Double Patenting over claims 3, 4, 6 and 19 of U.S. Patent 6,702,080. This rejection is respectfully traversed.

The factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness-type double patenting analysis are missing from the Office Action with respect to claims 1 to 4.

Because the rejection is based on 35 USC §103, what is in issue in such a rejection is "the invention as a whole", not just a small part of the preamble of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person

of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). By failing to address all of the features of claims 1 to 4, the rejection fails to evaluate the invention as a whole and the rejection is improper and should be withdrawn.

Moreover, as pointed out in MPEP 804, because the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Applicant respectfully submits that a *prima facie* case of double patenting has not been established because the Office Action fails to point out the differences between claims 1 to 4 of the present Application and claims 3, 4, 6 and 19 of U.S. Patent 6,702,080. Thus, the Examiner merely states that the subject matter claimed in claims 1 to 4 is fully disclosed in the patent and covered by the patent. What is disclosed in the patent is irrelevant since a double patenting rejection should address only the claims of U.S. Patent 6,702,080 and the claims of the present application. Also, the Examiner's general reference to "clutch devices, the shaft, the gear, the holder and the clutch spring with connecting portions" without addressing in a detailed

analysis the factual uniqueness set forth in Graham v. John Deere has obviated the requirements of 35 USC 103(a). Thus, for example, the relevant claims of U.S. Patent 6,702,080 do not recite "a gear in order to transmit the power received from the device pulley to an address gear" recited in claims 1 to 4 of the present application. All that is provided is a statement of similarities between the respective claims.

Moreover, there is no statement of why the unspecified differences between the claims 1 to 4 of the present Application and claims 3, 4, 6 and 19 of U.S. Patent 6,702,080 are obvious variations of each other.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

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Respectfully submitted,

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